

REMARKS

Reconsideration of the application and allowance of all pending claims are respectfully requested. Claims 1, 5-9, 13, 17, 21-24, 28, 32, and 37-45 are pending in the application.

35 U.S.C. §112 Rejection

In the Office Action, claims 1, 17, and 32 were rejected under 35 U.S.C. §112, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter of the invention. In particular, objection was raised as to what structural element corresponds to the "representation of a sports object usable by a participant in engaging in a sport." Applicants respectfully, but most strenuously, traverse this rejection for the reasons below.

As recited in independent claims 1, 17, and 32, applicants sports commemorator comprises "an object comprising at least one of an actual sports related object usable by a participant in engaging in a sport and a representation of a sports related object usable by a participant in engaging in a sport."

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While an actual sports related object may include, for example, a golf ball, a representation of a sports related object may include, for example, a miniature racing car.

Accordingly, the structural element corresponding to an object being "a representation of a sports related object usable by a participant in engaging in a sport " is not unclear. Withdrawal of this rejection is respectfully requested.

35 U.S.C. §103(a) Rejection

In the Office Action, claims 1, 5-9, 13, 17, 21-24, 28, 32, and 37-45 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Wilson et al. (U.S. Patent No. 5,813,546) in view of Feher (U.S. Patent No. 861,822) and Rand (U.S. Patent No. 405,678). Applicants respectfully, but most strenuously traverse this rejection for the following reasons.

Briefly summarized, applicants' invention as recited in the claims is directed to sports commemorators which includes in combination 1) a sports related object or representation thereof which is used by a participant in engaging in a sport, 2) a picture illustrating a scene relating to the sports related object, 3) the sports related object being visually associated with the picture, and 4) the sports related object not obscuring the picture.

With reference to Wilson, Wilson discloses a cap display apparatus. As stated in the Office Action, Wilson does not teach the display surface of the backing material having a picture thereon.

Moreover, Wilson does not disclose, teach or suggest a display surface having a scene relating to the sports related object, the sports related object being visually associated with the picture, or the sports related object not obscuring the picture.

Furthermore, Wilson specifically discloses that a "piece of backing material 33 provides a contrasting background for the cap 21." See, Wilson at column 2, lines 60-61. *Merriam Webster's Collegiate Dictionary*, Tenth Edition, 1993, defines "contrast" as "juxtaposition of dissimilar elements (as color, tone, or emotion) in a work of art."

With reference to Rand, Rand discloses a cabinet for preserving and displaying game such as a bird. The cabinet includes a cover made of glass with a projection or bulge which extends over and is spaced-apart from the stuffed game. The cover also extends over and is spaced-apart from a picture illustrating a scene of a beach and ocean.

Applicants respectfully disagree with the position taken in the Office Action that it would have been obvious to one having ordinary skill in the art at the time the invention was made to construct a display surface of the backing material of the cap display apparatus taught by Wilson with a picture on the backing material that corresponds with the three-dimensional object as taught by Rand to enhance the appearance of the display.

Specifically, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference. Rather, the test is what the combined teachings of those references would have suggested to those of ordinary skill in the art. In addition, the claimed combination cannot change the principle of operation of the primary reference or render the reference inoperable for its intended purpose. See, MPEP §2145.III, and MPEP §2143.01.

More importantly, the attempted combination of Wilson and Rand changes the principle of operation of the display disclosed in Wilson for showing off the cap, and in particular showing off the logos, designs, etc. which are typically embroidered on the front of the cap. In particular, attempting to incorporate a picture having a scene relating to the cap which is visually associated therewith improperly changes the basic principal under which the display in Wilson is constructed for showing off the cap with a contrasting background.

In addition, attempting to incorporate a picture having a scene relating to the cap which is visually associated therewith also renders the prior art unsatisfactory for its intended purpose, namely to show off the cap typically having logos, designs, etc. with a contrasting background.

Accordingly, it is respectfully submitted that the pending claims are patentable over the combination of Wilson et al. in view of Rand and Feher.

CONCLUSION

It is believed that the application is in condition for allowance and such action is respectfully requested.

If a telephone conference would be of assistance in advancing the prosecution of the subject application, applicants' undersigned attorney invites the Examiner to telephone him at the number provided.

Respectfully submitted,



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